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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/897,042	07/03/2001	Rudolf Valenta	1614-0251P	5581

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BIRCH STEWART KOLASCH & BIRCH
PO BOX 747
FALLS CHURCH, VA 22040-0747

EXAMINER

NOLAN, PATRICK J

ART UNIT	PAPER NUMBER
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1644

DATE MAILED: 07/29/2002

9

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/897,042

Applicant(s)
Valenta et al.

Examiner
Patrick J. Nolan

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1644



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on May 15, 2002
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 8, 9, and 14-27 is/are pending in the application.
- 4a) Of the above, claim(s) 8, 9, 14-20, 23, and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 21, and 22 is/are rejected.
- 7) ☒ Claim(s) 25-27 is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
*See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 6) ☐ Other:

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DETAILED ACTION

1. Claims 1-6, 8-9, and 14-24 and newly added claims 25-27 are pending.
2. Claims 8-9, 14-20, and 23-24 stand withdrawn from further consideration by the Examiner, 37 C.F.R. § 1.142(b) as being drawn to a non-elected invention.
3. Claims 1-6 and 21-22 and 25-27 are under consideration in the instant application.

Claim Rejections - 35 USC § 112

The following is a quotation of the **second** paragraph of 35 U.S.C. 112.

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-6 and 21-22 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicant's arguments filed 5-15-02 have been fully considered but are not found persuasive.

Applicant argues they can recite their claims as is well recognized by those in the art.

However, The claim would be more definite if it read " said fragment comprising an IgG epitope and an IgE epitope partly but not completely ".

Claim Rejections - 35 USC § 102 and Claim Rejections - 35 USC § 103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in

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order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-2, 4, and 6 stand rejected under 35 U.S.C. 102(b) as being anticipated by Rogers et al. (Molecular Immunology, 1994; 31(13): 955-966), for reasons set forth in Paper No. 7.
6. Claims 3 and 21 are rejected under 35 U.S.C. 103 as being unpatentable over Rogers et al. (Molecular Immunology, 1994; 31(13): 955-966), in view of U.S. Patent 4,629,783.
7. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rogers et al. (Molecular Immunology, 1994; 31(13): 955-966) in view of U.S. Patent 4,629,783 as applied to claim 21 above, and further in view of U.S. Patent 6,126,939.

Applicant's arguments filed 5-15-02 have been fully considered but are not found persuasive. Applicant argues that since Roger's et al., does not teach an IgG epitope, it does meet the claim limitations. However, Applicant is guided to MPEP section 2112 which discloses that once the office has established the prior art is substantially similar to the claimed invention, the burden shifts to Applicant to demonstrate the differences. In other words the burden is on Applicant to demonstrate all of the peptides disclosed by Rogers to be non-anaphylactic and not contain an IgE epitope do not contain an IgG epitope.

8. Claims 1-2 and 4-5 stand rejected under 35 U.S.C. 102(a) as anticipated by Vrtala et al. (J. Clin. Invest. 1997 April; 99(7): 1674-1681), for reason set forth in Paper No. 7.
9. Claims 1-2 and 4-6 are rejected under 35 USC 103 as being unpatentable over Vrtala et al. (J. Clin. Invest. 1997 April; 99(7): 1674-1681) in view of U.S. Patent 4,269,764.
10. Claims 3 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Vrtala et al. (J. Clin. Invest. 1997 April; 99(7): 1674-1681) in view of U.S. Patent 4,269,764 as applied to claims 1, 2, 4, and 6 above, and further in view of U.S. Patent 4,629,783.

Applicant states a 37 CFR 1.132 declaration is forthcoming.
The rejections are maintained.

11. Claims 25-27 are objected to as being dependent upon rejected claims.
12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

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13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patrick Nolan whose telephone number is (703) 305-1987. The examiner can normally be reached on Monday through Thursday from 9:30 am to 4:30 pm.

14. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Christina Chan, can be reached at (703) 305-3973. The FAX number for our group, 1644, is (703) 305-7939. Any inquiry of a general nature relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 308-0196.



Patrick J. Nolan, Ph.D.

Primary Examiner, Group 1640

7/27/02